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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,758	08/02/2001	Hiroaki Onishi	10921.99USWO	7944

7590 08/10/2005

Hamre Schumann Mueller & Larson PC  
P O Box 2902-0902  
Minneapolis, MN 55402

EXAMINER
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GIBBS, HEATHER D

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/890,758

Applicant(s)

ONISHI ET AL.

Examiner

Heather D. Gibbs

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3 and 5-17 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,3 and 5-17 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 22 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments see Page 6, filed 04/29/05, with respect to the rejection(s) of claim(s) 1,3,5-17 under newly found prior art references have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Onishi et al (US 5,859,421).

### ***Allowable Subject Matter***

2. The indicated allowability of claim 14 is withdrawn in view of the newly discovered reference(s) to Tamura (US 5,943,141). Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1,3,5,15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Onishi et al (US 5,859,421).

The applied reference has a common inventor/assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, which is representative of claims 5,15-16, Onishi discloses an image sensor comprising: a transparent cover having a first surface on an image reading region side, and a second surface away from the first surface; a light source throwing light to the image reading region from a second-surface side of the transparent cover; and a plurality of light receiving elements each receiving reflected light from the image reading region and outputting an image signal corresponding to an amount of the light received; characterized that the transparent cover includes a transparent main body of a synthetic resin, and a transparent glass member corresponding to the image reading region, that the transparent main body has a groove corresponding to the image reading region, the transparent glass member being placed in the groove; and that the transparent main body and the transparent glass member each has a surface which is flush with each other and provides the first surface (Col 2 Line 54-Col 3 Line 6; Col 3 Lines 23-32; Col 4 Lines 1-10).

For claim 3, Onishi teaches wherein the groove is provided by a through hole formed in the transparent cover (Col 3 Lines 7-13).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onishi et al '421 in view of Imagawa et al (US 5,455,412).

Onishi discloses the image sensor as described above.

Onishi does not disclose expressly wherein the transparent region is formed with a white spot or a black spot (Claim 6) and both the white spot and the black spot (Claims 7,9). Further, Onishi does not explicitly disclose wherein the image reading region is linear, the transparent cover having a nontransparent region corresponding to the other end of the portion of the image reading region (Claim 8).

Imagawa discloses wherein the transparent region is formed with a white spot or a black spot (Col 5 Lines 50-55; Fig 6); and both the white spot and the black spot (Fig 6); wherein the image reading region is linear, the transparent cover having a nontransparent region corresponding to the other end of the portion of the image reading region (Col 1 Lines 30-33; 62-Col 2 Line 10).

Onishi & Imagawa are combinable because they are from the same field of endeavor.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Imagawa with Onishi.

The suggestion/motivation for doing so would have been to measure amounts of light in the image reading region in both reflective and transmission mode, as taught by Imagawa et al.

Therefore, it would have been obvious to combine Imagawa with Onishi to obtain the invention as specified in claims 6-9.

7. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onishi et al '421 in view of Tamura (US 5,943,141).

Onishi discloses the image sensor as described above.

Onishi does not disclose expressly and wherein the nontransparent region is provided by part of the glass member rendered nontransparent (Claim 10) and applied with a coating (Claim 11). Onishi does not disclose wherein the nontransparent region is provided by a nontransparent member pasted to a part of the glass member (Claim 12) and separate from the glass member and the cover main body, placed in the groove (Claim 13). Lastly, Onishi does not disclose wherein the groove is divided into a glass member-receiving portion for receiving the glass member and a nontransparent member-receiving portion for receiving the nontransparent member (Claim 14).

Tamura discloses wherein the nontransparent region is provided by part of the glass member rendered nontransparent (Col 12 Line 66- Col 13 Line 2); and applied

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with a coating (Col 12 Line 66- Col 13 Line 2; "applied with a non-transparent member"); wherein the nontransparent region is provided by a nontransparent member pasted to a part of the glass member (Col 12 Line 66-Col 13 Line 2); and separate from the glass member and the cover main body, placed in the groove (Fig 12A; Col 12 Line 66- Col 13 Line 2); wherein the groove is divided into a glass member receiving portion for receiving the glass member and a nontransparent member receiving portion for receiving the nontransparent member (Col 12 Line 66- Col 13 Line 21; Fig 12A).

Onishi & Tamura are combinable because they are from image reading apparatus/sensor.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Onishi and Tamura.

The suggestion/motivation for doing so would have been to provide means for shade correcting.

Therefore, it would have been obvious to combine Tamura with Onishi to obtain the invention as specified in claims 10-14.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather D. Gibbs whose telephone number is 571-272-7404. The examiner can normally be reached on M-Thu 8AM-7PM.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Heather D Gibbs  
Examiner  
Art Unit 2622

hdg

  
EDWARD COLES  
PATENT EXAMINER  
CENTER 2600